

## REMARKS

This communication is in response to the Restriction Requirement dated July 7, 2006.

In the Restriction Requirement, the Examiner required election between thirteen alleged patentably distinct species of the claimed invention (Species I – XIII). In response to the Restriction Requirement, the Applicants provisionally elect Species I (Figure 1) with traverse as follows. The Applicants identify the following claims that are readable on the provisionally elected Species I: Claims 1-23 and 45-49.

### **Traversal**

The Applicants respectfully traverse the Restriction Requirement on the basis that it fails to meet the two criteria for a proper requirement for restriction between patentably distinct inventions. M.P.E.P. § 803 states that the two criteria for restriction between patentably distinct inventions are: (A) The inventions must be independent or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required.

#### ***(A) The Inventions Must Be Independent Or Distinct As Claimed.***

The restriction required is between thirteen alleged patentably distinct species of the claimed invention. The Applicants respectfully submit that the thirteen species identified in the Restriction Requirement do not represent distinct species of the invention. In the M.P.E.P. it is stated that:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. **This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristic of such species.** MPEP § 806.04(f). (Emphasis added).

The Applicants first respectfully submit that the Restriction Requirement has not identified limitations that are found in the different species that are mutually exclusive.

In addition, the Applicants further respectfully submit that Claim 1 is generic to the channel adapter disclosed in the Applicants' specification. Claim 1 recites a channel adapter (Fig. 1, Ref. 10) having five components: a host interface (Fig. 1, Ref. 18); a link interface (Fig. 1, Ref. 20); a packet processing engine (Fig. 1, Ref. 16); an address translation engine (Fig. 1, Ref. 12); and a completion queue engine (Fig. 1, Ref. 14). Each of the foregoing components of the claimed channel adapter is exploded in greater detail in subsequent figures. For example, the address translation engine 12 of Fig. 1 is depicted in greater detail in Fig. 2. As another example, the Inbound Request Logic of the address translation engine 12 in Fig. 2 is further depicted in greater detail in Fig. 3. Subsequent figures explode in greater detail the different components of Fig. 1. Thus, Claim 1 covers all versions of the figures presented in the application. None of the limitations of Claim 1 requires any specific species identified in the Restriction Requirement. Consequently, the Applicants respectfully submit that Claim 1 is generic to all of the species identified in the Restriction Requirement.

***(B) There Must Be A Serious Burden On The Examiner If Restriction Is Required.***

The Restriction Requirement has not established a *prima facie* case that there is a serious burden on the Examiner. In the M.P.E.P. it is stated that "[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. § 803. The M.P.E.P. § 803 further states that "[F]or purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." The M.P.E.P. § 808.02 finally concludes "[W]here, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, **no reasons exist for dividing among related inventions.**" (Emphasis added).

For all the foregoing reasons, the Applicants believe that the embodiments described in this application should be searched together. The Applicant further respectfully submit that a search to be conducted by the Examiner of any one of the thirteen species identified in the Restriction Requirement would necessarily encompass the subject matter of all the species. In other words, a search of any one of the thirteen figures would include a channel adapter having a host interface, a link interface, a packet processing engine, an address translation engine, and a completion queue engine. Thus, a search of all identified species could be made and the entire application examined without serious burden on the Examiner. Consequently, the Applicants respectfully request the withdrawal of the Restriction Requirement.

### **Provisional Election**

The Applicants provisionally elect, with traverse set forth above, the claims directed to the Species I. The Applicants identify Claims 1-23 and 45-49 as being readable on the provisionally elected Species I. The Applicants further respectfully submit that Claim 1 is generic, that the thirteen species identified by the Examiner do not represent distinct species of the invention, and that the entire application can be examined without serious burden on the Examiner.

### **Examiner Interview**

The Applicants acknowledge a teleconference on September 1, 2006, between Examiner Patel and Applicants' attorney, Alexander G. Vodovozov, during which withdrawal of the Restriction Requirement and provisional election of Species I readable on Claims 1-23 and 45-49 were discussed. No election was made. The Examiner did indicate acquiescence to Applicants' request for the withdrawal of the Restriction Requirement.

### Conclusion

The Applicants respectfully request the withdrawal of the Restriction Requirement and solicit early examination of the application on the merits in the forthcoming Official Action. The Applicants invite the Examiner to telephone the Applicants' attorney if there are any questions regarding this response and to facilitate prosecution of this application.

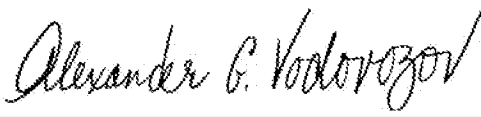
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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